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Andrew M. Calderon Greenblum and Bernstein P.L.C. 1950 Roland Clarke Place Reston, VA 20191			KARDOS, NEIL R	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/643,987	<b>Applicant(s)</b> AHERN ET AL.
	<b>Examiner</b> Neil R. Kardos	<b>Art Unit</b> 3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 February 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8,10,32-41 and 52-63 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8,10,32-41 and 52-63 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

This is a **FINAL** Office Action on the merits in response to communications filed on February 26, 2009. Claims 1, 32, 52, and 58 have been amended. Claims 59-63 have been added. Currently, claims 1-8, 10, 32-41, and 52-63 are pending and have been examined.

***Response to Amendment***

Applicant's amendment to claim 58 is sufficient to overcome the objection set forth in the previous Office Action.

Applicant's amendments to claim 1 are sufficient to overcome the rejection under § 101 set forth in the previous Office Action. Accordingly, this rejection has been withdrawn.

***Response to Arguments***

Applicant's arguments filed on February 26, 2009 have been fully considered but they are not persuasive. Applicant argues the following:

- (A) Ann does not disclose using a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels. (see Remarks, pages 12-15).
- (B) The present Office Action cannot be made final because "a clear issue was not developed between the examiner and applicant." (see Remarks, page 21).

The remainder of Applicant's arguments are moot in view of the new grounds of rejection, found below. This new grounds of rejection is necessitated by Applicant's

amendments to the claims; thus, the finality of the present Office Action is proper. Applicant's arguments will now be addressed in turn.

**(A) Ann does not disclose using a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels.**

Regarding argument (A), Examiner respectfully disagrees. Ann depicts a hierarchical relationship between elements of an organization in figures 4 and 5. Furthermore, Ann discloses linking strategic objectives, desired capabilities, business processes, information, and IT capabilities (see ¶¶ 13-14). Any change to one of these organizational levels impacts the other levels (id.). Paragraph 31 discloses a hierarchical navigation structure that begins with an overview section that allows navigation to other sections (¶ 31). Certain sections in the hierarchy allow access to other sections (see ¶ 32-40). Figure 5 and paragraph 41 illustrate the plurality of levels within Ann's hierarchy. For example, Ann discloses a specific hierarchy of "strategic directions 302 which are delivered by capabilities 304 which are drivers for principles 306....The capabilities 304 underpin the strategic direction 302 of the organization and are controlled by the principles 306" (see ¶ 41; see also ¶¶ 42-44, disclosing additional hierarchies with a plurality of levels). Ann's levels are also linked (see figure 5; ¶ 6, disclosing defined linkages; ¶¶ 13-14, disclosing links between elements in the hierarchy). Different levels in the hierarchy are linked to different elements. For example, in figure 5, capabilities are linked to strategic directions, features & functions, processes, and principles. Principles are linked to capabilities, application

software, and enterprise technology framework. Thus, the different levels of Ann's hierarchy have links that differ between the levels. Ann discloses this limitation.

Furthermore, additional references have been provided to teach the amended limitations of the claims. These references also teach the claimed limitation (see Chalmeta: page 181: table 1, disclosing abstraction levels where decision-making information is tied to the strategic, tactical, and operational level, as well as presenting an impact that an enterprise program generates on the enterprise; page 188: column 1: paragraph 2, disclosing a cost/benefit analysis of projects that are linked to processes; page 190: section 12, disclosing decision support systems such as cost models as part of the enterprise integration model; figure 7; see also Golightly: ¶ 83, disclosing that a value is linked to an element in the business model; ¶ 103, disclosing relating goals, values, capabilities, and resources; ¶¶ 105-106, disclosing that values are related to operations/processes; see also ¶¶ 108-109, disclosing hierarchical links; figure 6 and ¶¶ 114-117; ¶¶ 133-134; ¶ 140; ¶ 143, disclosing storing the models in a database).

**(B) The present Office Action cannot be made final because "a clear issue was not developed between the examiner and applicant." (see Remarks, page 21).**

Regarding argument (B), Examiner respectfully disagrees. A second or any subsequent action on the merits shall be made final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. See MPEP 706.07(a). In the present case, Examiner's new grounds of rejection is necessitated by Applicant's amendments to the claims; thus, the finality of the Office Action is proper. The limitation of Claim 35 "wherein

the enterprise architecture includes at least one of a hardware architecture and a software architecture" was properly rejected under Ann in view of Pisello and Patankar in the previous Office Action. Ann teaches this limitation in paragraph 25. Thus, the rejection was proper, and remains proper in the present Office Action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-8, 10, 32-41, and 52-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claims 1, 32, and 52:** Claim 1 recites "using a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource." It is not clear how these elements of the hierarchy are "linked." There appear to be missing elements of the hierarchy because the value depends on the capability, which in turn depends on a customer requirement; yet the customer requirement is not part of the hierarchy. Is the claimed "goal" the same as the claimed "customer requirement"? The value and the capability are defined in prior limitations, and their relationship is clear. However, the goal and the resource are not defined in prior limitations; thus, their hierarchical relationship to one another and to the value and capability is unclear. Examiner interprets this limitation to mean a database that stores and relates information (i.e. a goal, value, capability, and resource).

Furthermore, the claimed method stores a hierarchical relationship of a goal, value, capability, and resource, all of which are categories of information that can be used to make decisions. After this limitation, the claimed method partitions information relevant to enterprise decision making by creating categories of information and relating these categories to one another, wherein the information includes at least one of the value, the capability, and a resource. This later limitation also appears to be a database that stores and relates information. These limitations are very similar and it appears that the claimed method is performing the same step twice. Overall, the new limitations are confusing in light of the previous limitations.

Claims 32 and 53 are rejected under similar rationale as claim 1.

Claims 2-8, 10, 33-41, and 53-63: The dependent claims are rejected for failing to remedy the deficiencies of the claims from which they depend.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-8, 10, 32-41, and 52-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ann (US 2002/0198727) in view of Golightly (US 2003/0046130), and further in view of Chalmeta, "References Architectures for Enterprise Integration."**

Claim 1: Ann discloses a method for managing and tracking changes, the method comprising the steps of:

- defining at least one customer requirement for an enhancement to an enterprise architecture (see figure 5, disclosing strategic directions 302; ¶ 9, disclosing business requirements and objectives; ¶¶ 34 and 37);
- identifying at least one capability to provide the enhancement to the enterprise architecture (see figure 5, disclosing capabilities 304 supporting strategic directions 302; ¶¶ 13, 27, 36, 41, and 43, disclosing capabilities); and
- using a system implemented on a computer platform to partition information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another (see e.g. figure 5, depicting categories and their relationships), the information being defined by at least one of the value, the at least one capability (see figure 5, capabilities 304), and operational resources (see figure 5, organization units 312, roles & responsibilities 314, processes 316; ¶ 33);
- using an automated system to manage the categories of information (see e.g. ¶ 29, disclosing storing the categories and relationships in a computer).

Ann does not explicitly disclose:

- estimating at least one of a revenue increase and a cost saving associated with the at least one capability;

- determining a value provided by the at least one capability based upon an implementation cost and the at least one of the revenue increase and the cost saving

However, Ann does disclose analyzing the impact of proposed enterprise changes prior to implementation (see ¶¶ 6, 14, and 47). Golightly teaches estimating at least one of a revenue increase and a cost saving associated with a capability and determining a value provided by the capability based on implementation cost and at least one of the revenue increase and the cost saving (see ¶ 84, disclosing a cost and revenue model for systems, processes, conditions, etc.; ¶ 85, disclosing aggregating data sources of a model including cost of resources, cost of capital, etc.; ¶ 103, disclosing goals and objectives relating to profitability and cost; figure 6 and ¶¶ 116-117, disclosing costs in a hierarchy; ¶ 133, disclosing quantifying the impact of operational changes and delivering alternative strategies and tactics to meet the enterprise goals; ¶ 140, disclosing cost factors associated with production capabilities; ¶ 143, disclosing costs associated with production; the reference discloses a value associated with strategic capabilities based on revenues and costs). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the cost/benefit analysis techniques taught by Golightly when analyzing the impact of proposed changes disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate indication of the impact that a change will have on an enterprise.

Ann discloses using a database to store a hierarchical relationship (see ¶¶ 13-14, disclosing a database that links business components and allows for user navigation; ¶ 29) of a goal, the at least one capability, and a resource (see figures 4-5), the hierarchical relationship

having a plurality of levels with one or more dynamic links that differ between the plurality of levels (see figures 4-5; ¶¶ 13-14 and 29; the reference discloses different links at different levels of the hierarchy). Ann does not explicitly disclose that the hierarchy includes the value. However, Chalmeta more clearly discloses this limitation (see page 181: table 1, disclosing abstraction levels where decision-making information is tied to the strategic, tactical, and operational level, as well as presenting an impact that an enterprise program generates on the enterprise; page 188: column 1: paragraph 2, disclosing a cost/benefit analysis of projects that are linked to processes; page 190: section 12, disclosing decision support systems such as cost models as part of the enterprise integration model; figure 7). Examiner's note: See also Golightly (¶ 83, disclosing that a value is linked to an element in the business model; ¶ 103, disclosing relating goals, values, capabilities, and resources; ¶¶ 105-106, disclosing that values are related to operations/processes; see also ¶¶ 108-109, disclosing hierarchical links; figure 6 and ¶¶ 114-117; ¶¶ 133-134; ¶ 140; ¶ 143, disclosing storing the models in a database). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the hierarchies of Ann and Chalmeta to include all of the elements of a goal, value, capability, and resource. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate hierarchical model of an organization.

Ann does not explicitly disclose capturing and linking process measurements from one or more external modeling tools to the database to allow process performance to be accessed by the system. Golightly discloses this limitation (see ¶ 77, disclosing receiving process data; ¶¶ 83-85, disclosing receiving performance data values and models; ¶¶ 105-107, disclosing external inputs; ¶¶ 140 and 143, disclosing production performance). Golightly and Ann are both related to

frameworks for modeling a business. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine aspects of Golightly's architecture with aspects of Ann's architecture. This combination of known elements retains the functionality of the separate elements and produces a result that would be predictable to one of ordinary skill in the art. Furthermore, one of ordinary skill in the art would have been motivated to add the performance measurements of Golightly to the architecture of Ann for the benefit of efficiencies gained by tracking performance and using results to make better decisions.

Claim 2: Ann discloses mapping the at least one customer requirement to the at least one capability (see figure 5, items 302 and 304; ¶ 41).

Ann does not explicitly disclose comparing the value provided by the at least one capability with another value provided by at least one other capability and determining which capability provides optimum value.

However, Ann does disclose comparing proposed changes to the enterprise (see paragraph 47). Golightly teaches comparing values of capabilities to determine the optimum value (see ¶ 77, disclosing generating optimized decisions or actions to improve an organization; ¶ 86, disclosing maximizing profit; ¶ 115, disclosing optimization based on a set of decisions; figure 6; ¶ 129; ¶ 133, disclosing quantifying the impact of operational changes to deliver alternative strategies and tactics to meet the enterprise goals). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the compare alternative decisions as taught by Golightly when analyzing the proposed changes disclosed by Ann. One of

ordinary skill in the art would have been motivated to do so for the benefit of a more accurate determination of the best possible implementation.

**Claim 3:** Ann discloses wherein the identifying step includes identifying one or more strategic resources to support the at least one capability (see figure 5, items 316, 314, and 312; ¶¶ 13, 33, and 41-43).

**Claim 4:** Ann discloses wherein the identifying at least one capability step includes identifying at least one of a business process (see figure 5, item 316), a personnel skill/competency (see figure 5, item 314; ¶ 33), a physical entity (see figure 5, item 320), an information technology (see figure 5, item 342), a system component (see figure 5, item 330), and an infrastructure component (see figure 5, item 340).

**Claim 5:** Ann does not explicitly disclose assigning a weight to the one or more strategic resources and prioritizing the one or more strategic resources based on the assigned weight.

Golightly teaches this limitation (see ¶¶ 25, 53-54, and 158-159, disclosing assigning weights and coefficients to elements in a model, and the model includes resources as an element). Furthermore, it is old and well-known in the art to prioritize items. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the old and well-known weighting techniques like those taught by Golightly when analyzing change impact as disclosed by Ann. One of ordinary skill in the art would have been motivated to do so

for the benefit of a more accurate representation of the impact associated with enterprise changes.

Claim 6: Ann does not explicitly disclose assigning outcome based performance metrics to the one or more strategic resources.

Golightly discloses this limitation (see ¶ 85, disclosing providing performance information; ¶ 103, disclosing throughput and production rates of machinery; ¶ 140, disclosing production attributes such as cost, quality, yield, and capacity; ¶ 143, disclosing production rate, cycle times, quality summaries, and running production tallies). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the metrics taught by Golightly when analyzing the impact of changes as disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more efficient and accurate way to measure the impact of changes.

Claim 7: Ann discloses implementing the one or more strategic resources (see ¶ 47).

Golightly discloses tracking the one or more strategic resources based on the outcome based performance metrics (see ¶ 85, disclosing providing performance information; ¶ 103, disclosing throughput and production rates of machinery; ¶ 140, disclosing production attributes such as cost, quality, yield, and capacity; ¶ 143, disclosing production rate, cycle times, quality summaries, and running production tallies). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the business management techniques of Golightly into the method disclosed by Ann in order to track performance of implemented

projects. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately and efficiently determining the impact of implemented projects.

Claim 8: Ann does not explicitly disclose assigning a weight to the at least one capability; and prioritizing the at least one capability based on the assigned weight.

Chalmeta teaches this limitation (see page 181: table 2: open system, disclosing prioritizing projects; page 183: column 2: item 3, disclosing prioritizing projects; page 188: column 1: paragraph 1, disclosing prioritizing projects). Furthermore, it is old and well-known in the art to prioritize items.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the weighting techniques taught by Golightly when analyzing change impact as disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate representation of the impact associated with enterprise changes.

Claim 10: Ann discloses implementing the at least one capability (see ¶ 47).

Ann does not explicitly disclose assigning outcome based performance metrics to the at least one capability. Golightly discloses this limitation (see ¶ 85, disclosing providing performance information; ¶ 103, disclosing throughput and production rates of machinery; ¶ 140, disclosing production attributes such as cost, quality, yield, and capacity; ¶ 143, disclosing production rate, cycle times, quality summaries, and running production tallies). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the metrics taught by Golightly when analyzing the impact of changes as disclosed by Ann. One

of ordinary skill in the art would have been motivated to do so for the benefit of a more efficient and accurate way to measure the impact of changes.

Ann does not explicitly disclose tracking the at least one capability based on the outcome based performance metrics. Golightly discloses this limitation (see ¶ 85, disclosing providing performance information; ¶ 103, disclosing throughput and production rates of machinery; ¶ 140, disclosing production attributes such as cost, quality, yield, and capacity; ¶ 143, disclosing production rate, cycle times, quality summaries, and running production tallies). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the business management techniques of Golightly into the method disclosed by Ann in order to track performance of implemented projects. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately and efficiently determining the impact of implemented projects.

Claims 32-41: Claims 32-41 describe a system for carrying out the method steps recited in claims 1-10, rejected above. Ann, Golightly, and Chalmeta disclose such a system (e.g. a computer); thus, claims 32-41 are rejected under similar rationale as claims 1-10, rejected above.

Claim 52: Claim 52 describes a computer program product for carrying out the method steps recited in claim 1, rejected above. Ann, Golightly, and Chalmeta disclose such a computer program product (e.g. a computer); thus, claim 52 is rejected under similar rationale as claim 1, rejected above.

Claim 53: Ann discloses wherein the at least one customer requirement is defined in response to a request by a customer (see e.g. ¶ 9, 47).

Claim 54: Ann does not explicitly disclose wherein the value is monetary or in terms of strategic business worth. Golightly teaches this limitation (see e.g. ¶¶ 84-85, 94, 103-106, 109, 112, 116, 140, 143, 150, disclosing costs and revenues). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the analysis techniques taught by Golightly when analyzing the impact of proposed changes disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate indication of the impact that a change will have on an enterprise.

Claim 55: Ann does not explicitly disclose wherein the outcome based performance metrics are defined and tested by conducting facilitates working sessions or building simulation models.

Golightly teaches this limitation (see Golightly generally; the disclosure is directed to predictive models. It would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the simulations of Golightly when analyzing the impact of changes as disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more efficient and accurate way to measure the impact of changes.

Claim 56: Ann does not explicitly disclose wherein the estimates are at least one of entered, recorded, or modified as additional real performance information is observed.

Golightly discloses this limitation (see at least ¶ 83).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the estimates taught by Golightly when analyzing the impact of proposed changes disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate indication of the impact that a change will have on an enterprise.

Claim 57: Ann discloses allowing at least one organizational executive to track functionality (see ¶ 39, disclosing tracking changes in the system). Golightly also discloses tracking and flagging capabilities (see at least ¶¶ 29-33 and 83). Examiner maintains Official Notice that it was well-known in the art at the time the invention was made to flag areas of concern while tracking and monitoring performance. Thus, It would have been obvious to one of ordinary skill in the art at the time the invention was made to flag certain capabilities while tracking and monitoring performance as disclosed by the cited references. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by closely monitoring areas of concern.

Claim 58: Ann does not explicitly disclose using the assigned weight to make a decision based on one or more of the implementation cost, the revenue increase, and the cost saving. Golightly teaches this limitation (see at least ¶¶ 6, 25, 29-33, 56, 77, 115, 137-151). Furthermore, Examiner maintains Official Notice that it was well-known in the art at the time the invention was made to prioritize items and make decisions based on those priorities. Thus, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to use the weighting techniques to make decisions as taught by Golightly when analyzing change impact as disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate representation of the impact associated with enterprise changes.

Claim 59: Ann discloses providing the user with a plurality of dynamic links to operational elements of the system (see figures 4 and 5; ¶¶ 13-14, disclosing allowing users to navigate through linked elements; ¶¶ 29-31, disclosing the same; ¶ 39). Ann does not disclose every one of the claimed links. However, the claimed links amount to non-functional data such as a mere arrangement of data. Such nonfunctional descriptive material is not given patentable weight absent a new and unobvious functional relationship between the nonfunctional matter and the substrate. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); MPEP 2106.01. Where the only difference between the prior art product and the claimed invention is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); MPEP 2112.01(III).

Claim 60: Ann discloses storing updates to the database dynamically as changes are made to the hierarchical relationship (see ¶¶ 13-14 and 29-30, disclosing storing the architecture in a database that can be modified).

Claim 61: Ann discloses using the system to transition the at least one capability into actual operations (see ¶ 6, disclosing facilitating changes in the enterprise; ¶ 9; ¶ 14, disclosing allowing the impact of proposed changes to be assessed prior to implementation).

Claim 62: Ann discloses determining whether the at least one capability supports and satisfies a customer value (see ¶¶ 13-14, disclosing linking capabilities and objectives; ¶¶ 5, 25, 28, 30, and 43, disclosing customer value).

Claim 63: Ann does not explicitly disclose the limitations of this claim. Chalmeta discloses conducting a tradeoff analysis and a business case analysis, the tradeoff analysis being based on a cost, a time factor, and a benefit (see page 188: column 1: paragraph 2, disclosing a cost/benefit analysis and meeting physical requirements; page 190: section 12, disclosing decision support systems; page 183: column 2: item 3, disclosing sorting priority of short, medium, and long term projects). It would have been obvious to one of ordinary skill in the art at the time the invention was made to conduct a tradeoff analysis as disclosed by Chalmeta when considering the enterprise changes disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of selecting the most effective and efficient projects to implement.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Fox, Mark S., and Michael Gruninger, "Enterprise Modeling." *AI Magazine*, 19:3 (1998), pp. 109-121
- Yu, Eric, "Strategic Modelling for Enterprise Integration." *Proceedings of the 14<sup>th</sup> World Congress of the International Federation of Automatic Control* (July 5-9, 1999).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos  
Examiner  
Art Unit 3623

/Neil R. Kardos/  
Examiner, Art Unit 3623  
/Jonathan G. Sterrett/  
Primary Examiner, Art Unit 3623